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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,319	06/18/2001	James Graham	22058-568 DIVIACON	4845

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09/09/2003

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EXAMINER

MERTZ, PREMA MARIA

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 09/09/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/884,319

Applicant(s)

GRAHAM ET AL.

Examiner

Prema M Mertz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17 and 26-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 17 and 26-38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 10.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 17, 26, 30-38, drawn to an antibody to a protein comprising the amino acid sequence set forth in SEQ ID NO:2, classified in class 530, subclass 387.9.
- II. Claims 17, 27, 30-38, drawn to an antibody to a protein comprising the amino acid sequence set forth in SEQ ID NO:4, classified in class 530, subclass 387.9.
- III. Claims 17, 28, 30-38, drawn to an antibody to a protein comprising the amino acid sequence set forth in SEQ ID NO:6, classified in class 530, subclass 387.9.
- IV. Claims 17, 29, 30-38, drawn to an antibody to a protein comprising the amino acid sequence set forth in SEQ ID NO:7, classified in class 530, subclass 387.9.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-IV are independent and distinct, each from the other, because each of the antibodies to each of the different polypeptides is materially different products, which are structurally and chemically different, capable of separate manufacture and use. The products in the different Groups are physically and chemically distinct from each other, and if patentable would support separate patents. Distinctness is further shown because a search of one of the antibodies would not reveal art pertinent to the other and each of these products could be made and used without any one or more of the other products. Separate searches would be required for searching each of the antibody products eg. a search of the literature for the antibody to polypeptide of SEQ ID NO:7 would not necessarily reveal art for the antibody to the polypeptide

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of SEQ ID NO:2. Therefore, each of the antibodies are not related and are properly restrictable in accordance with MPEP. § 806.04 and MPEP. § 808.01.

Furthermore, each of the antibodies of Groups I-IV do not share a common technical feature, which is based on a common property or special technical feature not found in the prior art. These antibodies are independent and distinct chemical compounds lacking either a common structural property which distinguishes them as a group from structurally related compounds of the prior art or which provides them with a common utility which is lacking from those prior art elements.

The first claimed invention fails to recite such a feature, since the claim recites an antibody to a polypeptide “comprising” the amino acid sequence of SEQ ID NO:2, which encompasses an antibody to FLAG protein which antibody is found in the prior art. The text on page 23 of the instant specification encompasses a polypeptide of SEQ ID NO:2, which can include a “tag”. Because of the presence of the term “comprising” in the instant claims, they encompass any antibody which can bind to any epitope which can be expressed as a portion of a polypeptide comprising the amino acid sequence as set forth in SEQ ID NO:2 and, therefore they essentially encompass any antibody which can bind to any polypeptide or protein comprising a “tag”. Group I encompasses an antibody which binds to any antigenic peptide, including the flag epitope DYKDDDDK which was bound by the antibody of Hopp et al. (U.S. Patent 5,011,912, 4/1991) prior to the time of the instant invention. The reference discloses the antibody (column 5, lines 55-59) meeting the limitations of an antibody to a polypeptide “comprising” the amino acid sequence of SEQ ID NO:2. Since the first claimed invention lacks

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a special technical feature, the other claimed inventions cannot share a special technical feature with the first claimed invention.

Having shown that these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their recognized divergent subject matter as defined by MPEP.. § 808.02, the Examiner has *prima facie* shown a serious burden of search (see MPEP.. § 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (703) 308-4229. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.


Official papers filed by fax should be directed to (703) 872-9306. Faxed draft or informal communications with the examiner should be directed to (703) 746-5300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

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All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


Prema Mertz Ph.D.
Primary Examiner
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September 5, 2003